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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,989	12/08/2005	Nobuhiro Hasegawa	5404/127	6554

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1796

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11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,989	Applicant(s) HASEGAWA ET AL.	
	Examiner Marc S. Zimmer	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 15 is/are rejected.
- 7) ☒ Claim(s) 2 and 8-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/08/05, 06/22/06, 10/15/07</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-7 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama et al., JP 7-173404 A. Nakayama teaches a film-forming composition comprising a hydrolyzable silyl group-functionalized vinyl polymer, a film forming agent (paragraph 76), and a UV stabilizer. One permutation of the film forming agent is that where “m” equals one and R⁵ denotes a hydrogen atom in which case the film-forming agent is the α,β -diol ethylene glycol. Exemplary of the vinyl monomers from which the vinyl polymer is derived are the acrylic esters mentioned at the beginning of paragraph 54.

Claims 1, 3-7, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kodera et al., JP 57-12058. See the abstract.

Allowable Subject Matter

Claims 2 and 8-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Although the Examiner has not yet obtained a full translation of the latter of the two aforementioned references, it seems clear that the limitations of claims 2 and 8-10 as living free radical polymerization had not been developed as of the time of that publication.

The ISA cites numerous other documents as being germane to the patentability of the present claims. For instance, JP 11-12455 is said to at least render obvious all of the claims in light of what is taught in paragraphs 58 and 63. The Examiner has reviewed these paragraphs and other parts of that disclosure and did not see any mention of diols/polyols. Rather, there were disclosed *esters of polyols* such as pentaerythritol tetrastearate. Likewise, paragraph 190 of JP 2001-354830 seems to only describe polyol esters. JP 7-26154 appears to have a disclosure nearly equivalent to JP 7-173404 and is, therefore, redundant.

Concerning JP 11-193343, it is insinuated that the teachings of this reference, which appears to be devoid of any mention of a vinyl polymer component may be combined with those of any of the other references to realize a new composition that contains both a silyl group-functional vinyl polymer and a polyether bearing crosslinkable groups. *In re Kerkhoven* 205 USPQ 1069 states that, "it is prima facie obvious to combine two compositions, each of which is taught by prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose." Notwithstanding this ruling, the Examiner believes that the proper nexus for combining these references is lacking. Further, there are literally thousands of references that individually disclose the employment of silyl-functional polyethers or silyl functional acrylic polymers for making sealant, adhesive, and coating compositions. It would seem to be a stretch to assert that it would be obvious to combine the teachings of any one reference reciting a silyl-functional acrylic with those of any other reference

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disclosing a silyl-functional polyether simply because both contemplate using the invention for coating applications. Rather, there would have to be evidence that a similar problem associated with coating materials/methods was being addressed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 29, 2007


MARC S. ZIMMER
PRIMARY EXAMINER